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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/716,650

11/19/2003

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EXAMINER

VEZERIS, JAMES A

ART UNIT

PAPER NUMBER

4172

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/716,650	<b>Applicant(s)</b> MCLIESH ET AL.	
	<b>Examiner</b> James A. Vezeris	<b>Art Unit</b> 4172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **Detailed Action**

#### **Claim Rejections- 35 U.S.C. 112 2<sup>nd</sup> Paragraph**

1. Claims 2, 4, 15, 17, 24, and 30 recite the limitation "...investor holding the second financial instrument..." in reference to transfer funds or change terms of a financial instrument. There is insufficient antecedent basis for this limitation in the claims. Claims 1, 14, and 27 refer to a consumer using the given method. In the dependent claims, an investor seems to gain control over the funds without any mention of the steps done to accomplish the transfer.
2. Claims 13, 26, and 39 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language used in the claims, "...at least one of receiving..." creates confusion as to what the applicant is trying to say. For the purpose of examination the examiner interprets the claim to be, "...managing the second financial instrument implements at least one of the following steps, receiving the funds associated with the first financial instrument, increasing the funds by the first amount, or transferring the increase funds."

#### **Claim Rejections- 35 U.S.C. 103(a)**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over “CD’s are Not Risk Free, So Shop Around” (Hereinafter “CD”), by the Pittsburgh Post in view of US-PGPub #20020077966 to Harycki et al. (Hereinafter “Harycki”).

**Regarding Claims 1, 14, and 27:**

CD teaches providing, to a consumer having a first financial instrument, a second financial instrument, the method comprising:

receiving funds associated with the first financial instrument held with a first institution, the funds having been reduced by a penalty for closing the first financial instrument; (See CD Paragraphs 6 and 7”)

CD fails to teach increasing the funds by a first amount based on the reduced funds due to the penalty and transferring the increased funds to the second financial instrument. However Harycki does. (See figure 1 Paragraphs 53 and 54)

It is therefor obvious to combine CD and Harycki to allow for the transferring of funds. A person skilled in the art would be motivated to combine the two references because it allows a user to make more money through incentives and higher returns.

**Regarding Claims 2, 15, and 24:**

CD fails to further teach providing an investor holding the second financial instrument an option to transfer the funds to a third financial instrument based on predetermined account criteria. However Harycki does. (See Harycki paragraph 60)

It is therefor obvious to combine CD and Harycki to allow for the transferring of funds to yet another instrument. A person skilled in the art would be motivated to combine the two references because it allows a user to make more money through

incentives and higher returns.

**Regarding Claims 3, 16, and 29:**

CD fails to further teach the predetermined account criteria comprises a predetermined period of time. (See Harycki paragraphs 59, 59, and 60)

It is therefor obvious to combine CD and Harycki to allow for the transferring of funds after a period of time. A person skilled in the art would be motivated to combine the two references because it allows a user to make more money through incentives and higher returns.

**Regarding Claims 4, 17, and 30:**

CD fails to further teach providing an investor holding the second financial instrument an option to change the terms of the second financial instrument based on predetermined account criteria. Harycki does. (See Harycki paragraphs 59, 59, and 60)

It is therefor obvious to combine CD and Harycki to allow for an investor to change the terms of the second financial instrument. A person skilled in the art would be motivated to combine the two references because it allows a user to make more money through incentives and higher returns.

**Regarding Claims 5, 18, and 31:**

CD fails to further teach the predetermined account criteria comprises a predetermined period of time. Harycki does. (See Harycki paragraphs 59, 59, and 60)

It is therefor obvious to combine CD and Harycki to allow for an investor to change the terms of the second financial instrument after a specified amount of time. A person skilled in the art would be motivated to combine the two references because it

allows a user to make more money through incentives and higher returns, at the same time allowing the financial institution the ability to manage the changes the investor could make.

**Regarding Claims 6, 19, and 32:**

CD fails to further teach the third financial instrument has a rate of return greater than the second financial instrument. Harycki does. (See Harycki paragraphs 60)

It is therefor obvious to combine CD and Harycki to allow for the transferring of funds after a period of time. A person skilled in the art would be motivated to combine the two references because it allows a user to make more money through incentives and higher returns.

**Regarding Claims 7, 19, and 33:**

CD fails to further teach the second financial instrument and the third financial instrument are managed by a second financial institution. Harycki does. (See Harycki paragraphs 59, 59, and 60)

It is therefor obvious to combine CD and Harycki to allow for the transferring of funds after a period of time. A person skilled in the art would be motivated to combine the two references because it allows a user to make more money through incentives and higher returns. It also allows the second financial institution to maintain a strong customer base.

**Regarding Claims 8, 21, and 34:**

CD, along with Harycki further teaches at least one of the first financial instrument, the second financial instrument, and the third financial instrument comprise

at least one of a certificate of deposit, a jumbo certificate of deposit, a promissory note, and a time deposit. (See CD paragraphs 6 and 7 and Harycki paragraph 53)

It is therefor obvious to combine CD and Harycki to allow for the transferring of funds. A person skilled in the art would be motivated to combine the two references because it allows a user to make more money through incentives and higher returns.

**Regarding Claims 9, 22, and 35:**

CD fails to further teach at least one of receiving the funds, increasing the funds, and transferring the increased funds further comprises communicating over a network. Harycki does. (See Harycki paragraphs 64)

It is therefor obvious to combine CD and Harycki to allow for control of funds over a network. A person skilled in the art would be motivated to combine the two references because it allows a user to make more money through incentives and higher returns in an easier more convenient method.

**Regarding Claims 10, 23, and 36:**

CD fails to further teach communicating over the network further comprises communicating with a user device on the network, the user device being located in at least one of a home, an office, a store, a retail center kiosk, and an office of a financial institution. Harycki does. (See Harycki paragraphs 64)

It is therefor obvious to combine CD and Harycki to allow for control of funds over a network. A person skilled in the art would be motivated to combine the two references because it allows a user to make more money through incentives and higher returns in

an easier more convenient method.

**Regarding Claims 11, 24, and 37:**

CD further teaches the penalty is an early withdraw penalty. (See CD Paragraphs 6 and 7)

It is therefor obvious to combine CD and Harycki to allow for the transferring of funds. A person skilled in the art would be motivated to combine the two references because it allows a user to make more money through incentives and higher returns.

**Regarding Claims 12, 24, 38:**

CD further teaches the penalty is an amount equal to between three and six months interest on the first financial instrument. (See CD paragraph 7)

It is therefor obvious to combine CD and Harycki to allow for the transferring of funds. A person skilled in the art would be motivated to combine the two references because it allows a user to make more money through incentives and higher returns.

**Regarding Claims 13, 25, and 39:**

CD fails to further teach a second financial institution managing the second financial instrument implements at least one of receiving the funds associated with the first financial instrument, increasing the funds by the first amount, and transferring the increase funds. Harycki does. (See Harycki paragraphs 59, 59, and 60)

It is therefor obvious to combine CD and Harycki to allow for the second institution to manage the second instrument. A person skilled in the art would be motivated to combine the two references because it allows a user to make more money



through incentives and higher returns as well as creating loyalty to the second financial institution.

### **Relevant Art**

US-PG Pub 20020069150 to Ni is relevant due to it teaching incentives to clients based on amount of time they have been with the institution.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Vezeris whose telephone number is 571-270-1580. The examiner can normally be reached on Monday-alt. Fridays 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Naeem Haq/

/James A Vezeris/

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Primary Examiner, Art Unit 4172

Examiner, Art Unit 4172

November 8, 2007